

REMARKS

Upon entry of the above amendments, this application will contain claims 1-5, 8, 9, 12, 14, 16, 18, 20, 22, and 26 pending and under consideration. In the present Response, claim 15 has have been canceled. Claims 1, 2, 3-5, and 12 have been amended.

As discussed more fully below, it is believed that this application is now in condition for allowance. Prompt reconsidering leading to allowance of all pending claims is respectfully requested.

I. Rejection Under 35 USC § 112

Claim 15 was rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. It is believed that claim 15 is sufficiently definite for one skilled in the art. However in order to advance the prosecution of this application, claim 15 has been canceled.

II. Rejection Under 35 USC § 112

Claims 1-5, 8, 9, 12, 14-16, 18, 20, 22 and 26 were rejected under 35 U.S.C. 112, second paragraph, as indefinite; specifically:

- a) In claim 1, the variable(s), “-NR⁷R⁸ -OC₁-C₆ alkylaryl” for R₁, was questioned. A comma has been inserted between the amine group and the alkoxy group. Thus confirming that this is two separate groups.
- b) In claim 1, the variable “C₁-C₆ alkylalcohol” for R⁵ was considered vague and indefinite. The applicants respectfully traverse this rejection. It is believed that this term is sufficiently definite for one skilled in the art to ascertain its meaning. However in order to advance the prosecution of this application, claim 1 has been amended to delete reference to this group.
- c) In claim 1, the list of variables for R⁷ was considered vague as an improper Markush format. In line 20, the word --and-- was inserted between “heterocyclic” and “aryl”.
- d) Claim 2 ends in a comma instead of a period. On line 6, the comma has been replaced with a period.
- e) Claim 3, on line 2 recites “-OC₂-C₆ alkenyl”, which lacks antecedent basis in claim 1. In claim 3, line 2, the term -OC₂-C₆ alkenyl has been deleted.
- f) In claim 4 the “and” between the “C₁-C₆ alkylheterocyclic” and “C₃-C₈ cycloalkyl” is misplaced. In claim 4, line 2, the “and” has been deleted and added on line 3 before “aryloxy”.
- g) In claim 4, a period is misplaced after “C₃-C₈ cycloalkyl”. In claim 4, on line 2, the

period has been deleted.

- h) Claim 5 lacks antecedent basis for the phrase “y is a bond”. In claim 5, line 1, the lower case “y” has been replaced with an capital --Y--.
- i) Claim 5 the term “alkylcycloalkyl” was considered vague/indefinite. Claim 5, on line 2, has been amended to recite --C₁-C₆ alkylcycloalkyl-. See claim 1, line 7 for support.
- j) Claim 5 lacks of antecedent basis for “alkyl” in line 2. Claim 5, on line 2 has been amended to delete this term.
- k) Claim 5 lacks of antecedent basis for “hydroxy”, “C₁-C₆ alkylcycloalkyl, C₃-C₈ cycloalkyl, C₁-C₆ alkylaryl, aryloxy, -OC₂-C₆ alkenyl, -OC₁-C₆ haloalkyl, -OC₃-C₈ cycloalkyl, and -OC₁-C₆ alkylaryl”. Claim 5 has been amended to delete reference to these terms in lines 4-6 in addition on line 4, an –and—has been added between “--COOH, C₁-C₆ alkyl” and “C₁-C₆ alkoxy”.
- l) Claim 8 recites q is 1-3. The applicants believe that the claim is not vague or indefinite as one skilled in the art will readily understand that the notation “q is 1-3” is equivalent to the notation q is 1, 2, or 3. To hold otherwise is elevating form over substance. However in order to advance the prosecution of this application, claim 8 has been amended to recite --q is 1, 2, or 3--.
- m) Claim 12 lacks of antecedent basis for 5-[Acetyl-(3,5-bis-trifluoromethyl-benzyl)-amino]-2-methyl-7-trifluoromethyl-2,3,4,5-tetrahydro-benzo[b]azepine-1-carboxylic acid isopropyl ester. It is respectfully submitted that this rejection is improper. Claim 12 is an independent claim, and not dependent upon claim 1. As such claim 12 can include compounds not encompassed within the scope of claim 1. However in the prior submission, the undersigned voluntarily withdrew other compounds having R² substituents, which would include the instant compound. This compound is now also canceled from claim 12. The undersigned preserves the right to pursue these compounds in a continuing application.
- n) Claim 12 lacks of antecedent basis for:
6-[Acetyl-(3,5-bis-trifluoromethyl-benzyl)-amino]-8-trifluoromethyl-3,4,5,6-tetrahydro-2H-benzo[b]azocine-1-carboxylic acid isopropyl ester,
6-[Acetyl-(3,5-bis-trifluoromethyl-benzyl)-amino]-9-trifluoromethyl-3,4,5,6-tetrahydro-2H-benzo[b]azocine-1-carboxylic acid isopropyl ester, and
5-[Acetyl-(3,5-bis-trifluoromethyl-benzyl)-amino]-9-trifluoromethyl-3,4,5,6-tetrahydro-2H-benzo[b]azocine-1-carboxylic acid isopropyl ester.

These compounds have been deleted from claim 12 as part of the non-elected invention.

- o) Claim 15 was considered vague and indefinite. Claim 15 has been canceled. Therefore this rejection is moot.

III. Conclusion

In light of the above claim amendments and comments withdrawal of all rejections is requested. Applicants respectfully request timely reconsideration examination of this application leading to allowance of all pending claims. The Examiner is invited to contact the undersigned attorney by telephone if there are any questions about this Response or other issues that may be resolved in that fashion.

Respectfully submitted,

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